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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,859

11/21/2003

Pascal Jordil

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7590

05/05/2004

PEARNE & GORDON LLP

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CLEVELAND, OH 44114-3108

EXAMINER

GUADALUPE, YARITZA

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,859	JORDIL ET AL.	
	Examiner	Art Unit	
	Yaritza Guadalupe	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,12-14,17-19 and 28-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,12-14,17-19 and 28-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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2. Claims 1 – 3, 12 – 14, 17 – 19 and 28 – 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 29 of copending Application No. 09/996,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter disclosed by claims 1 – 3, 12 – 14, 17 – 19 and 28 – 37 of the present application are clearly disclosed by claims 1 – 29 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

3. Claims 12 and 14 are objected to because of the following informalities:

a. Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). : Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 – 3, 12 - 14, 17 – 19 and 29 are rejected under 35 U.S.C. 102 (b) as being anticipated by Glasson (US 5,781,450).

Glasson discloses a coordinate measuring machine comprising a probe tip (22) designed for being brought into contact with the piece (16) to be measured, a displacement mechanism of said probe tip for movement in the three dimensional axes (x, y, z) as shown in Figure 1. Glasson further discloses a measuring and displaying system

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(14, 31, 38) that allows the position of said probe tip to be determined and displayed, said measuring and displaying system being able to function according to several distinct modes (See Column 6, lines 26 – 39), wherein at least one of said measure modes can be selected by acting on the position of the probe tip without any other handling operating being necessary. Glasson discloses said measure mode being selected by pressing the probe tip against the piece to be measured during a time interval greater than a predetermined value, since coordinates from the direction of movement of the probe will determine the feature type, which implies that some time interval is present so as to obtain the measurements from / with the probe.

Glasson discloses an apparatus comprising a command program for measuring and displaying in a dimension – measuring column, said program enabling the position of the probe tip of said measuring column to be determined and displayed in computer monitor (31), said program being capable of making said measuring and displaying system function according to several distinct modes, wherein said program enables another of said measure modes to be selected by acting on the position of the probe tip, said program being performed by a computer (14).

With respect to claims 1 – 3, 14 and 15 : The method enabling a command to switch the measure mode to be entered in a dimension – measuring column provided with a probe tip wherein said command to switch the measure mode is entered by only making use of the position of said probe tip (See Column 6, lines 26 – 39), wherein said command to switch the measure mode is entered by pressing the probe tip against a piece

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to be measured during a time interval greater than a predetermined value, and wherein a measurement of the probing point is effected when the probe tip is pressed against said piece to be measured during a time interval shorter than said predetermined value can be made by the regular operation of the apparatus disclosed Glasson.

6. Claims 30 – 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kimura et al. (US 6,401,352).

Kimura et al. discloses a linear measuring machine comprising a probe tip (13) designed for being brought into contact with the piece to be measured, a displacement mechanism of said probe tip for movement in one dimensional axis (z) as shown in Figure 1. Kimura et al. further discloses a measuring and displaying system (16, 17, 18) that allows the position of said probe tip to be determined and displayed, said measuring and displaying system being able to function according to several distinct modes, wherein at least one of said measure modes can be selected by acting on the position of the probe tip by means of deliberate handling operation of a height – command crank (43), thus resulting in modifying the measuring accuracy and / or resolution. Kimura et al. discloses said measure mode being selected by pressing the probe tip against the piece to be measured during a time interval greater than a predetermined value, since coordinates from the direction of movement of the probe will determine the feature type, which implies that some time interval is present so as to obtain the measurements from / with the probe.

The method as stated in claims 30 – 35 will be met by the regular operation of the apparatus disclosed by Kimura et al.

2. Claims 36 – 37 are rejected under 35 U.S.C. 102 (e) as being anticipated by Matsuki et al. (US 6,307,084).

Matsuki et al. discloses a touch signal probe system comprising a probe tip (100, 102) designed for being brought into contact with the piece to be measured, a displacement mechanism of said probe tip for movement in at least one dimensional axis (x, y, z) as shown in Figure 6. Matsuki et al. further discloses a measuring and displaying system (50, 70, 90, see columns 9 and 10, lines 63 – 67 and 1 – 6 respectively) that allows the position of said probe tip to be determined and displayed, said measuring and displaying system being able to function according to several distinct modes, wherein said dimension measuring column enable detecting a pressing force between the probe tip and the object under measurement so as to switch the measuring mode during a time interval greater than zero (See Column 4, lines 14 – 20 and 31 – 37).

Matsuki et al. discloses said measure mode being selected by pressing the probe tip against the piece to be measured during a time interval greater than a predetermined value, since coordinates from the direction of movement of the probe will determine the feature type, which implies that some time interval is present so as to obtain the measurements from / with the probe.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 28 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Glasson (US 5,781,450) in view of Tsukamoto et al. (US 5,991,706).

Glasson discloses a coordinate measuring machine as stated in paragraph 5 above.

Glasson does not disclose the loudspeaker as stated in claim 28.

Regarding claim 28 : Tsukamoto et al. discloses a measuring apparatus comprising a control device (30) having an operation panel (8) for selecting a desired operational measuring mode (See Column 6, lines 30 – 41) and also having a loudspeaker / sound generator (14) for signaling. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a loudspeaker / sound generator as taught by Tsukamoto et al. to the apparatus disclosed by Glasson in order to provide a safety mechanism which produces a loud indication if a change has occurred in the process that will alert the user at long distances.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are considered of relevance to the present application :

- b. Ogihara et al. (US 6,044,569)
- c. Cresson (US 6,301,796)
- d. Wampler et al. (US 5,898,590)
- e. Ercole et al. (US 5,883,313)
- f. Hama et al. (US 6,357,134)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (571)272 - 2244. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yaritza Guadalupe
Patent Examiner
Art Unit 2859
April 30, 2004



CHRISTOPHER W. FULTON
PRIMARY EXAMINER